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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/053,621	01/24/2002	Richard C. O'Brien	618-1047	5284

20582 7590 04/09/2003

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EXAMINER

LE, HUYEN D

ART UNIT	PAPER NUMBER
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3751

DATE MAILED: 04/09/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/053,621

Applicant(s)

O'BRIEN ET AL.

Examiner

Huyen Le

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 January 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) 1-19, 21, 23-28, 30 and 31 is/are allowed.
- 6) ☒ Claim(s) _____ is/are rejected.
- 7) ☒ Claim(s) 20, 22, 29 and 32 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-13, 23 and 24 are rejected under 35 U.S.C. 102(b) as being anticipated by Finkenauer et al (DE 4229976).

The Finkenauer et al reference discloses a barrel 12 having a channel with an opening end; a writing element 16 disposed in the channel and movable along a longitudinal axis between a retracted position and an extended position; a least a portion of said writing element is resilient; the writing element 16 is deflected in a direction substantially transverse to the longitudinal axis upon being moved into the extended position; and the resiliency of the writing element 16 biases the writing element 16 to engage the channel and to retain the writing element 16 in the extended position.

Regarding claim 3, the writing instrument comprises a first engagement member 62 associated with the writing element 16, wherein the first engagement member 62 engages the channel.

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Regarding claim 4, the first engagement member 62 is a pawl.

Regarding claim 5, the writing instrument comprises a second engagement member 46.

Regarding claim 6, the second engagement member 46 is an indentation formed on the channel.

Regarding claim 7, the second engagement member 46 is a ledge formed on the channel.

Regarding claims 8 and 23, the writing instrument comprises a sleeve member 14 disposed in the channel for receiving a portion of the writing element, wherein the sleeve member engages the channel to retain the writing element in the extended position.

Regarding claims 9 and 24, the writing instrument comprises a first engagement member 62 located on the sleeve member 14.

Regarding claim 10, the writing element 16 is a living spring.

Regarding claim 12, the movement of the writing element 16 in a direction substantially transverse to the longitudinal axis is caused by bending the writing element 16.

3. Claims 1-6, 8-19, 21, 23 and 24 are rejected under 35 U.S.C. 102(e) as being anticipated by Lin (6,200,050).

The Lin reference discloses a barrel 1 having a channel with an opening end; a writing element 2 disposed in the channel and movable along a longitudinal axis between a retracted position and an extended position; a least a portion of said writing

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element 2 is resilient; a writing element 2 is deflected in a direction substantially transverse to the longitudinal axis upon being moved into the extended position; and the resiliency of the writing element 2 biases the writing element 2 to engage the channel and to retain the writing element 2 in the extended position.

Regarding claim 3, the writing instrument comprises a first engagement member 422 associated with the writing element 2, wherein the first engagement member 422 engages the channel.

Regarding claim 4, the first engagement member 422 is a pawl.

Regarding claim 5, the writing instrument comprises a second engagement member 13.

Regarding claim 6, the second engagement member 13 is an indentation formed on the channel.

Regarding claims 8 and 23, the writing instrument comprises a sleeve member 42 disposed in the channel for receiving a portion of the writing element, wherein the sleeve member 42 engages the channel to retain the writing element in the extended position.

Regarding claims 9 and 24, the writing instrument comprises a first engagement member 422 located on the sleeve member 42.

Regarding claim 10, the writing element 2 is a living spring.

Regarding claim 12, the movement of the writing element 2 in a direction substantially transverse to the longitudinal axis is caused by bending the writing element 2.

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Regarding claim 14, the writing instrument comprises a release member 411 located on a side surface of the barrel 1 and movable from a rest position to a release position; wherein movement of the release member to the release position disengages the writing element 2 from the channel.

Regarding claim 15, the movement of the release 411 to the release position bends the writing element 2 in a direction substantially transverse to the longitudinal axis.

Regarding claim 17, a portion 412 of the release member 411 contacts the first engagement member 422.

Regarding claim 18, a portion 412 of the release member 211 contacts the writing element at a location spaced apart from the released member.

Regarding claim 19, the release member 411 is a cantilever beam.

Regarding claim 21, the release member 411 is pivotally coupled to the barrel 1.

4. Claims 25, 27, 28 and 30 are rejected under 35 U.S.C. 102(b) as being anticipated by Greer, Jr. (5,564,849).

The Greer, Jr. reference discloses a writing instrument comprising a barrel 30 having a channel and an open end through which a writing element 39 is extendable along a longitudinal axis; and an actuator member 55 disposed on a side surface of the barrel 30 and movable between a first position defining a first length between the actuator member 55 and the open end along the longitudinal axis, and a second position defining a second length between the actuator member 55 and the barrel open end along the longitudinal axis, the second length being shorter than the first length;

wherein the actuator member 55 moves along a non-linear path between the first position and the second position.

Regarding claim 27, the actuator member moves along an arcuate path between the first position and the second position.

Regarding claim 28, the actuator member 55 is disposed on a non-planar surface, and slides along the non-planar surface between the first position and the second position.

Regarding claim 30, the writing instrument comprises a writing element 39 disposed in the channel and moveable between a retracted position and an extended position; wherein the writing element 33 is in the retracted position when the actuator member 55 is in the first position; and the writing element is in the extended position when the actuator member 55 is in the second position.

Allowable Subject Matter

5. Claims 20, 22, 29 and 32 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The Yu reference shows a writing instrument comprising a writing element being deflected in a traverse direction to a longitudinal axis upon being moved into an extended position. The Kitzerow reference shows a writing instrument having an

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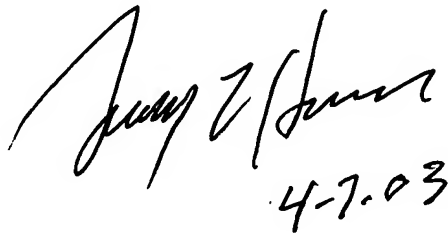
actuator member moving along a non-linear path between a retracted position and extended position

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Huyen Le whose telephone number is 703-306-5504. The examiner can normally be reached on Monday-Friday from 9:00 am to 6:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory Huson can be reached on 703-308-2580. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-7766 for regular communications and 703-872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0861.

HL
March 31, 2003



4-7-03

GREGORY HUSON
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3700